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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,980	08/04/2003	Richard C. Everett	03KS01	2989

7590  
Edward E. Roberts  
P.O. Box 3206  
Dana Point, CA 92629

03/30/2007

EXAMINER

SCHWARTZ, CHRISTOPHER P

ART UNIT

PAPER NUMBER

3683

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/30/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/632,980

Applicant(s)

EVERETT ET AL.

Examiner

Christopher P. Schwartz

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

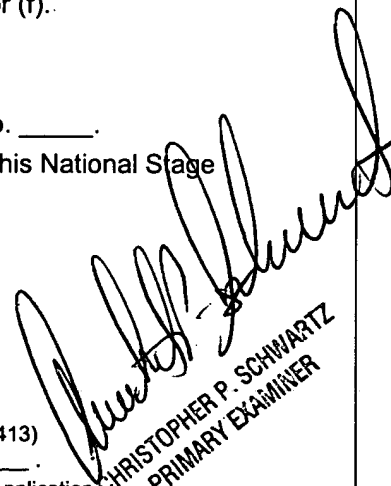
- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

  
CHRISTOPHER P. SCHWARTZ  
PRIMARY EXAMINER

### DETAILED ACTION

1. Applicant's response filed January 19, 2007 has been received and considered.

Claims 1-6 and 8-20 are currently pending. Claim 7 has been canceled.

#### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-6,8-20 rejected under the judicially created doctrine of obviousness-

type double patenting as being unpatentable over claims 1-16 of U.S. Patent No.

6,892,863 in view of Smith '747 or Huang. Although applicant's prior patent shows most of the features of the present application, lacking are the particulars of the end cap.

As previously explained the reference to Smith teaches it is old and well known in the art to provide such a removable closure means or end cap that is secured with pin type connection at 10.

The newly cited reference to Huang shows in figure 2 a similar device to that of Smith. Note that the pad holder has an integrally formed closed end, and shows yet another known alternative for securing the pads

It would have been obvious to one of ordinary skill in the art to have modified the claims of the patent to include such a removable closure means, and one that matches the contour of the holder means -- for proper functioning of the pad, to make replacement of the pads easier. It is notoriously well known in the art to make singular parts plural and vice-versa as a matter of obvious engineering design to make replacement of certain parts easier, for easier shipping and storage etc.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-6,8-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irvine in view of Everett '959 and Smith '747 or Penney or Huang.

Regarding claims 1-6,8-20 Irvine shows in figure 3 a brake pad similar to applicants. Note the brake pad means 28 and the pad at 12.

Irvine lacks a showing of multiple brake pads having different braking compounds in sequential abutting relationship. Irvine also lacks closure means, in the form of an end cap, for complementary mating with the truncated end to secure the brake pads within the brake pad means.

It is notoriously well known in the art to make singular parts plural as a matter of obvious engineering design choice, or possibly, for easier replacement.

Everett '959 is relied upon to show it is well known to create brake pads having different compounds for desired braking and wear characteristics. See figure 5 and the abstract.

Smith is relied upon to show it is known in the art to make a brake pad or shoe from multiple parts. See elements 2. Note also the closure means at 9 and 10.

Penney is relied upon for a teaching similar to Smith. Note the closure means in the area of c and f.

The newly cited reference to Huang shows in figure 2 a similar device to that of Irvines'. Note that the pad holder has an integrally formed closed end, and shows yet another known alternative for securing the pads.

One having ordinary skill in the art at the time of the invention would have found it obvious to have made the different pad sections shown in figure 3 of Irvine from multiple abutting pad sections having differing compounds, as taught collectively by

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Everertt and Smith or Penney or Huang, to achieve a particular set of brake and wear characteristics desired from the pad.

To make the multiple pads easier to assemble, and replace them after they have worn, one having ordinary skill in the art would have found it obvious to have made a matching section, or end cap, to fit over the open end at 34 and secured as claimed, and for proper functioning of the pad, as generally suggested by the removable closure means in either Smith or Penney. Such a modification would simply amount to an alternate equivalent means (albeit possibly a more expensive one) of securing the pads within the means 28 as shown by Irvine at 38. It is notoriously well known in the art to make singular (integral) parts plural and vice-versa as a matter of obvious engineering design to make replacement of certain parts easier, for easier shipping and storage etc.

Regarding claims 2,4 as explained above and as seen in the drawings of the references applied these requirements are met.

Regarding claim 3 simply to make the pad means with a longitudinal curvature in conformance to that of the wheel rim would have been obvious to achieve optimum braking results. Note the curvatures in Smith and Penney.

Regarding claims 5,6 as broadly claimed, applicants limitations are simply an alternative equivalent "strengthening agent" to that shown by Irvine in figure 3 since Irvine provides an overlap portion on the support member 28 to prevent the brake pads from being removed. Further, glue or adhesive would be an obvious modification to the back and/or sides of the pads to make removal more difficult.

Regarding claim 7 these limitations are simply an obvious variation of what is collectively taught by the references above. Also see the discussion columns 1 and 2 of Irvine.

Regarding claims 8-18 as explained above these limitations are taught collectively by the combination of the references above.

Regarding claims 19 and 20 it would have been an obvious method to insert the multiple brake pads sequentially, as modified above, as this would easily be seen as the easiest and most expedient method of assembly.

### ***Response to Arguments***

7. Applicant's arguments filed January 19, 2007 have been fully considered but they are not persuasive. The examiner maintains the position that ordinary skilled worker in the art would have arrived at the claimed invention in light of the combination of teachings of the references above. While applicant's claim a brake pad assembly essentially having multiple pads, with different friction coefficients, and a removable end cap having a shape and contour matching the pad holder, the references applied against the claims teach this combination of elements. The reference to Irvine in figure 3 teaches a similar arrangement to applicant's. Lacking is the pad formed from multiple elements, friction coefficients and an end cap assembly.

But these elements are taught by Everett (see top of col. 2 and middle portion of col. 3) and Smith or Penney. It is notoriously well known in the art to make singular parts plural as a matter of obvious engineering choice.

Therefore, it would have been obvious to have provided the brake assembly of Irvine with a matching end cap to positively secure the pads and to keep the multiple pads from moving around in the assembly.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Schwartz whose telephone number is 571-272-7123. The examiner can normally be reached on M-F 9:30-6:00.

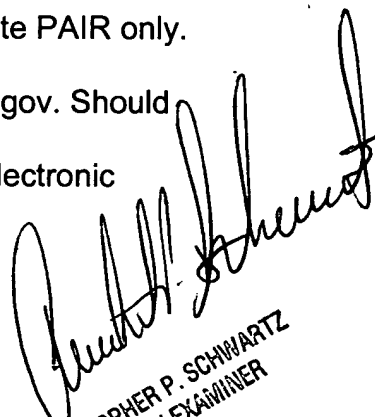
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim McClellan can be reached on 571-272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-272-7099.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cps  
3/28/07



CHRISTOPHER P. SCHWARTZ  
PRIMARY EXAMINER